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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,831	10/11/2001	Kamal Acharya	NETS0085	3000
22862	7590	09/11/2008		
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			EXAMINER DUNHAM, JASON B	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 09/11/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/975,831	<b>Applicant(s)</b> ACHARYA ET AL.	
	<b>Examiner</b> JASON B. DUNHAM	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 6-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 6-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 17, 2008 has been entered. Applicant amended claims 1 and 22. Claims 1, 3, and 6-25 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The last two limitations of independent system claim 23 do not recite any underlying structure for the search request. It is unclear what structure allows the user to choose a target location.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3, and 6-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pricscan (PTO-892, Ref. U) in view of McGlinn (US 2002/0152134) and further in view of Biswas (US 6,594,666).**

Referring to claim 1. Pricscan discloses a method for providing an integrated electronic list of providers, comprising:

- Determining at least one online provider for an item (Pricscan: page 4);
- Determining at least one offline provider for an item (Pricscan: page 4);
- Wherein the determining steps follow a request for a product (Pricscan: page 10);
- Integrating the at least one online provider with the at least one offline provider to provide an integrated list of providers for the item (Pricscan: page 4);
- Pricscan does not explicitly disclose distinguishing online from offline providers in a list. McGlinn discloses:
  - Distinguishing online providers from offline providers in said integrated list (McGlinn: abstract). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of

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Pricescan to have included distinguishing online from offline providers, as taught by McGlinn, in order to increase consumer trust (McGlinn: abstract).

- The combination of Pricescan and McGlinn discloses searching by physical location (McGlinn: paragraph 23) but does not explicitly disclose a user choosing a target location or radius. Biswas discloses:
- Wherein when the request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored (Biswas: abstract and column 5, lines 25-30);
- Wherein when the request is for a predetermined proximity to a target location, the user may choose a radius for said target location (Biswas: abstract and column 5, lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Pricescan and McGlinn to have included requests for geographical areas wherein a user may choose a target location and requests for a proximity to a target location wherein a user may choose a radius to said target, as taught by Biswas, in order to allow the user to receive comparison shopping within a geographic area of interest. The examiner notes that in the interest of expediting prosecution, the last two limitations have been treated, however, the recited "when" recitations do not move to distinguish the claimed invention from the cited art. These phrases are conditional limitations with the noted "when" step not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a

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whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: In re Johnston, 77 USPQ2d 1788 (CA FC 2006); Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C].

Referring to claim 3. The combination of Pricescan, McGlinn and Biswas further discloses a method wherein the request is for a product category (Pricescan: Page 3).

Referring to claim 6. The combination of Pricescan, McGlinn and Biswas further discloses a method including providing comparison information for the at least one online provider and the at least one offline provider for the item (Pricescan: pages 3-5).

Referring to claims 7-13. The combination of Pricescan, McGlinn and Biswas further discloses methods wherein the comparison information includes price, rating, review, availability, promotion, electronic wallet, and return-policy comparison (Pricescan: pages 3-12).

Referring to claim 14. The combination of Pricescan, McGlinn and Biswas further discloses a method providing comparison information about at least two offline providers (Pricescan: page 4).

Referring to claims 15-16. The combination of Pricescan, McGlinn and Biswas further discloses a method wherein the comparison information includes in-store return and pick-up policies of online purchase (Pricescan: page 4).

Referring to claims 17-18. The combination of Pricescan, McGlinn and Biswas further discloses a method wherein the comparison information includes special promotions and coupon availability information (Pricescan: page 4).

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Referring to claims 19-20. The combination of Pricescan, McGlinn and Biswas further discloses a method wherein the comparison information includes proximity and direction to the at least two offline providers (Biswas: column 5, lines 25-30).

Referring to claim 21. The combination of Pricescan, McGlinn and Biswas further discloses a method wherein the comparison information includes user review (Pricescan: page 12).

Referring to claims 22-23. Medium and system claims 22-23 are rejected under the same rationale set forth above in the rejection of method claim 1 containing similar limitations.

Referring to claim 24. The combination of Pricescan, McGlinn and Biswas further discloses a system implemented on a network environment (Pricescan: pages 3-12).

Referring to claim 25. The combination of Pricescan, McGlinn and Biswas further discloses a system wherein the network environment comprises a global communications network (Pricescan: pages 3-12).

### ***Response to Arguments***

Applicant's arguments with respect to the above claims have been considered but are moot in view of the new ground(s) of rejection. In response to applicant's remarks regarding the alternative language present in independent claims 1, 22, and 23, exception is taken that a "gratuitous and hyper-technical position" was devised by the Office to maintain the final rejection dated January 25, 2008. Per MPEP 2106,

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limitations must be positively recited, as noted in the rejection of claim 1 above. No admission is made that final rejection was improper as asserted by the application. Further exception is taken to applicant's position that the examiner's arguments are "meritless" in the January 25, 2008 office action. The previous grounds of rejection (originally presented in the May 30, 2007 action) were maintained in that action and not withdrawn as alleged by the applicant. The Office has treated each claim upon its merits and invites the applicant to contact the Examiner should further discussion regarding positively recited limitations be helpful. A suggested amendment for the last limitation of claim 1 would be: responsive to a determination of a ~~where when the~~ request is for a predetermined proximity to a target location, the user may choose a radius for said target location.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Dunham/  
9/8/08